

REMARKS

Claims 4-7, 34, 37, 38, 46, 49-51, 53-63, 65, 72, 74-78, 94-96 and 100 are pending. Claims 2, 3, 11-14, 28-34, 37, 64, 67, 68, 92, 93 and 101-103 are canceled. Applicants request entry of amendments to claims 4-7, 34, 37, 38, 46, 49, 50, 51, 63 and 65. The basis for the amendments can be found throughout the specification especially in the examples. Most notably claim 34 has been amended to include the subject matter of claim 103 with the subsequent canceling of claim 103. The claims not cancelled that depended from claim 103 are now amended to depend from claim 34. These amendments have been made to better clarify the claims. Claim 104 has been newly added and is supported in the specification for example starting at page 21, paragraph 80.

Finality of the Current Office Action

In response to the Office Action in the above-identified application dated May 5, 2006, Applicants amended claims 2-7, 11-14, 28-31, 34, 46, 63-65, 67, 68 and 92-94 and cancelled claims 1, 8-10, 15-27, 35, 36, 39-45, 47, 48, 52, 66, 69-71, 73, 79-91 and 97-99. Claim 1 was canceled and rewritten as new claim 102 to more clearly define original claim 1. New claim 103 was also added that incorporated additional elements relative to the claim scope of claim 102. The other claim amendments were made to clarify the claims. In total the claim additions and amendments provided a clarified claim set to the office of equal scope or of a scope that incorporated additional elements relative to the previous claim set.

The currently claimed embodiment can be found in the claims as originally filed. For example originally filed claim 34 claimed a composition comprising first and second oligomeric compounds wherein at least one of the oligomeric compounds had nucleosides of a first type and nucleosides of a second type that alternated for some length, etc. Claim 37 (dependent on 34) required that at least one of the first and second oligomeric compounds comprise only nucleosides of said first type and said second type and that these alternated for the entire length of the oligomeric compound. Claim 49 (dependent on 34) limited one of the nucleosides of a first and second type to 2'-H which is β-D-deoxyribonucleosides. The claims as filed therefore included a composition having two oligomeric compounds wherein at least one of the oligomeric compounds was alternating β-D-deoxyribonucleosides with another nucleoside that was 2'-modified.

In the Office Action dated October 19, 2006 (the current action), under the conclusion on page 5 the Office states that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." As stated above the claims presented to the Office in the response mailed August 3, 2006 were simply clarified and in some instances incorporated additional elements but no new broadening claims or amendments were presented that would have expanded the claim scope to cover previously unclaimed subject matter. Applicants respectfully request that the finality of the rejection be withdrawn.

Rejection Under 35 U.S.C. §103(a)

Claims 2-7, 11-14, 28-34, 37, 38, 46, 49-51, 53-65, 67, 68, 72, 74-78, 92-96 and 100-103 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Elbashir *et al.*, The EMBO Journal, 2001, Vol. 20, No. 23, pages 6877-6888 (the Elbashir reference); Fosnaugh *et al.*, US 2003/0143732 (the Fosnaugh reference); and Morrissey *et al.*, US 2003/0206887 (the Morrissey reference). Claims 2, 3, 11-14, 28-34, 37, 64, 67, 68, 92, 93 and 101-103 have been canceled herein obviating the rejection against these claims. Applicants respectfully traverse the rejection for the following reasons.

Applicants submit that the office action has not established a *prima facie* case of obviousness. The current amended claim set is drawn to double stranded compositions comprising first and second chemically synthesized oligomeric compounds, the first oligomeric compound is capable of hybridizing with at least a portion of the second oligomeric compound and also has complementarity to and is capable of hybridizing to a selected nucleic acid target, at least one of the first and second oligomeric compounds comprises a contiguous sequence of linked nucleosides that define an alternating motif of the formula 5'-Q(-L-Z-L-Q)_n(-L-Z)_{nn}-3' where each L is an internucleoside linking group and each Q or each Z is a β -D-deoxyribonucleoside and the other of each Q or each Z is a 2'-substituted nucleoside wherein the 2'-substituent group is other than H or OH, with each oligomeric compound being from about 18 to about 30 nucleosides in length. All claims currently depend directly or indirectly to claim 34 including claim 100 which is the only method claim. Note that the formula 5'-Q(-L-Z-L-Q)_n(-L-Z)_{nn}-3' is newly added to better define and clarify what is being claimed e.g. linked nucleosides that define an alternating motif and allowing for both even and odd lengths.

The present claims are not obvious in view of the cited references because they don't teach or suggest a double stranded composition wherein one strand has a defined arrangement of modified nucleosides as claimed, e.g. one strand has an alternating motif comprising β -D-deoxyribonucleosides and 2'-modified nucleosides.

In summary, claims 4-7, 34, 37, 38, 46, 49-51, 53-63, 65, 72, 74-78, 94-96 and 100 are not obvious in view of the Elbashir reference, the Fosnaugh reference and the Morrissey reference. It is believed all of the claims presently before the Office patentably define the invention over the prior art and are otherwise in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

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PATENT

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